

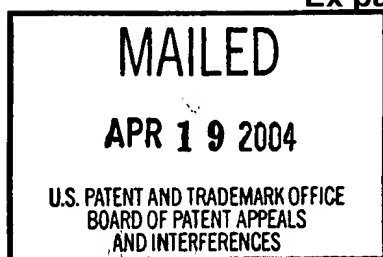
The opinion in support of the decision being entered today
was **not** written for publication in a law journal and
is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID S. DUNNING and JOEL C. DODD



Appeal No. 2003-0206
Application No. 08/766,895

ON BRIEF

Before JERRY SMITH, FLEMING and NAPPI, **Administrative Patent Judges**.
NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the
examiner's rejection of claims 1 to 27¹.

¹ It is noted that claims 9 and 22 as presented in Appendix A of the appeal brief were not identical to the claims presented to the examiner during prosecution. Accordingly, this decision is based upon claim 9 as presented in the original filing of December 13, 1996 and claim 22 as presented by the amendment dated May 6, 1999.

The Invention

The invention relates to a method of routing packets of data through a network using encoded signals, see page 2 of appellants' specification. As shown in figure 2, the packet of data includes a destination address header (301), a payload of data of signals to be transferred (320) and a trailer, see also appellants' specification page 8 lines 17-20. The packet is encoded, several coding schemes are addressed on page 9 of appellants' specification however lines 8-9 of that same page state "[t]he invention is not limited in scope to a particular coding scheme." The binary signals for the header are selected such that when encoded they directly provide the routing information to a network switch which routes the packet through the network, see page 10, line 3 through page 11, line 4 of appellants' specification. The advantage of this is that it reduces the circuitry needed in the switch, see page 11, line 5 of appellants' specification.

Claim 17 is representative of the invention and is reproduced as follows:

17. A method of routing a packet of binary digital signals through a network, said method comprising:

receiving at a switch in the network the packet of binary digital signals as encoded binary digital signals including a bit pattern chosen so that when the bit pattern is encoded it directly provides information regarding routing the packet through the network in its encoded form without decoding.

References

Huang et al.	5,442,474	August 15, 1995
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Rejections at Issue

Claims 1 to 27 stand rejected under 35 U.S.C. § 102 as being anticipated by Huang et al. Rather than repeat the arguments of appellants or the examiner we make reference to the appeal brief and the examiner's answer for the respective details thereof.

CLAIM GROUPING

According to appellants (Brief, page 6), "[c]laims 1-27 stand or fall together." Since all claims stand or fall together, we limit our discussion to representative independent claim 17. Claims 1-16 and 18-27 will stand or fall together with claim 17. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

Opinion

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of the appellants and the examiner, for the reasons stated *infra* we will sustain the examiner's rejection of claims 1-27 under 35 U.S.C. § 102.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In order to consider the examiner's application of the applied prior art to the appealed claims, we must first interpret the claims in light of the written description in appellants' specification as it would be interpreted by one of ordinary skill in this art. See generally, In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). "The terms used in the claims bear a "heavy presumption" that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." Texas Digital Sys, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002).

“Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted.” (citation omitted). “Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected.” Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d at 1204, 64 USPQ2d at 1819 (Fed. Cir. 2002). (“[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty.”); id. (citing Liebscher v. Boothroyd, 258 F.2d 948, 951, 119 USPQ 133, 135 (C.C.P.A. 1958) (“Indiscriminate reliance on definitions found in dictionaries can often produce absurd results.”)). “In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning.” Id. “Further, the presumption also will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.” Id. .

Claim 17 includes the limitation “when the bit pattern is encoded it directly provides information regarding routing the packet through the network in its encoded form without decoding.” Appellants’ specification provides no definition for the meaning of “information regarding routing of the packet through the network.” However, in light of the following passages in appellants’ specification, we interpret the limitation of “information regarding routing the packet through the network” to include designation of a path for routing the packet through the network to a destination or the address of the packet’s destination. See appellants’ specification: page 8 lines 16-18 “...the packet includes a destination address as part of a header 310...”, page 9 lines 16-17 “... and decoded so that the switch may determine the route or destination address,...” and page 10 lines 7-8 “... the header that provides the switch information on how to route the packet to a destination port or address...”, page 10, lines 16-17 talking about the header “the sequence of ones and zeros designate a path through a series of coupled bi-directional cross bar switch elements...”

The term “directly” as used in claim 17 is not defined in the specification, however the plain meaning of “no intervening step” is supported by the appellants’ specification. See page 10 lines 9-12 of the appellants’ specification,

which state "instead a bit pattern is chosen so that when the bit pattern is encoded it directly provides information regarding routing the packet through the network in its encoded form. Therefore, the encoded binary digital signals specify a route through the network without decoding."

Accordingly, we hold that the scope of claim 17 includes an encoded bit pattern which contains information in the form of an address or designation of a path for routing the packet through the network, and that the bit pattern presents the information to the switch without requiring the interim step of decoding the pattern.

The examiner provided two explanations of how Huang taught the limitations of the encoded bit pattern. On page 7 of the examiner's answer, the examiner states:

Huang clearly teaches that the header bit pattern is made unique by using a special hear (sic) bit coding so that it can be readily detected (directly provides information). Since the header bits appears (sic) at the beginning of the packet, in front of the routing bits, the detection of the header bits means that the routing bits will follow. In other words, the header bits provide the information regarding when the routing bits arrive. It is further noted that the routing bits are used to specify how the packet is to be routed through the network.

The Examiner then provides an alternate explanation²

² It is noted that the alternate explanation of the rejection was not included in the final rejection. However, this is not considered a new grounds of rejection as both the statutory basis for the rejection and the basic thrust of the rejection have remained the same and appellants were given an opportunity to react to the rejection by filing a reply brief under 37 CFR § 1.193(b)(1). See In re Kroning 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

It is further noted that the claimed 'bit pattern chosen so that the bit pattern directly provides information regarding routing the packet' can also read on Huang's routing bits for the following reasons: Huang's routing bits also provide routing information in its encoded form (see col. 6, lines 14-31 and col. 6 line 59 to col. 7, line 20). The combination of the two binary routing bits simply provides (sic) four possible paths for each packet, e.g. 00 takes [the] first path, 01 takes [the] second path, etc. Decoding is not needed. The receiver does not need a decoder to use this (sic) routing bits.

Appellants argue in the brief, on page 8 that "the header bits do not represent any encoded information that dictates the destination of the data" and "the header bits H1 and H2 do not contain any information encoded or otherwise, that designates where the data is to be routed." On page 9 of the brief, the appellants argue that the examiner's final Office action ignored language in the claims and failed to address the term directly in claim 1. Appellants assert,

the header bits described by Huang do not contain any information regarding the routing of the packet. Since the header bits themselves do not contain any routing information, it is not possible for the header bits to directly provide information regarding the information.

We are convinced by the arguments presented by the appellants. As addressed above we find that claim 17 includes an encoded bit pattern which contains an information in the form of an address or designation of a path for routing the packet through the network, and that the bit pattern presents the information to the switch without requiring the interim step of decoding the pattern. We find

that the header bits of Huang do not meet this limitation, as they do not convey information regarding the routing of the packet.

However, with respect to the examiner's second rationale for the rejection, we find that the examiner has presented a prima facie finding of anticipation.

The examiner has shown how the routing bits present routing information directly to the switch. Our reviewing court has said, "when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (citing In re King 801 F2d 1324, 1327, 231 USPQ 136, 138) (Fed Cir 1986).

Appellants have not presented arguments rebutting the examiner's second rationale for finding of anticipation. Appellants' arguments with respect to the header bits in Huang are not relevant to the examiner's second rationale, which relies upon the routing bits of Huang. Accordingly, we find that the appellants have not carried the burden of proof to overcome the examiner's prima facie rejection of claim 17.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are

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deemed waived by appellants [see 37 CFR § 1.192(a)] Support for this rule has been demonstrated by our reviewing court in In re Berger 279 F3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) where in the Federal Circuit Court stated that because the appellants did not contest the merits of the rejections in his brief to the Federal Circuit Court, the issue is waived. Also see In re Watts 354 F.3d 1362, 13268, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

In view of the forgoing, we have sustained the examiner's rejection of claims 1-27 under 35 USC § 102.

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No time period for taking any subsequent action in connection with this
appeal may be extended under 37 CFR§ 1.136 (a).

AFFIRMED


JERRY SMITH
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge

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